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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,280	01/16/2004	Alain Tornier	79740-345359	5143

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FAEGRE & BENSON LLP  
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90 SOUTH SEVENTH STREET  
MINNEAPOLIS, MN 55402-3901

EXAMINER
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HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/758,280	TORNIER ET AL.	
	Examiner	Art Unit	
	Mary Hoffman	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/18/2006, 10/12/2006, 02/05/2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/21/2007, 02/21/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/2006 has been entered.

### ***Election/Restrictions***

Applicant's election with traverse of Group II, claims 14-32 in the reply filed on 02/05/2007 is acknowledged. The traversal is on the ground(s) that searching the inventions of Group I and II would not place an undue burden on the examiner. This is not found persuasive. In response to applicant's argument that the search of all the inventions is similar and, thus, the burden on the examiner would not be significant, "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification" (see M.P.E.P. § 808.02). In the instant case, the inventions have separate classifications. The requirement is still deemed proper and is therefore made FINAL.

Claims 1-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or

linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02/05/2007.

The requirement is still deemed proper and is therefore made FINAL.

### ***Allowable Subject Matter***

The indicated allowability of claims 14-15 is withdrawn in view of the newly discovered reference(s) to Roche (U.S. Patent No. 4,632,111) and Glock (U.S. Patent No. 5,116,339). Rejections based on the newly cited reference(s) follow.

### ***Claim Objections***

Claims 14-23 are objected to because of the following informalities:

In claim 14, line 11, "deformable" is misspelled and should be changed to --deformable--.

In claim 23, line 2, "of the deformable ring a constituted" is not grammatically correct and should be changed to --of the deformable ring are constituted--.

In claim 26, line 3, "the rigid part" should be changed to --a rigid part-- to be clearer for examination purposes.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

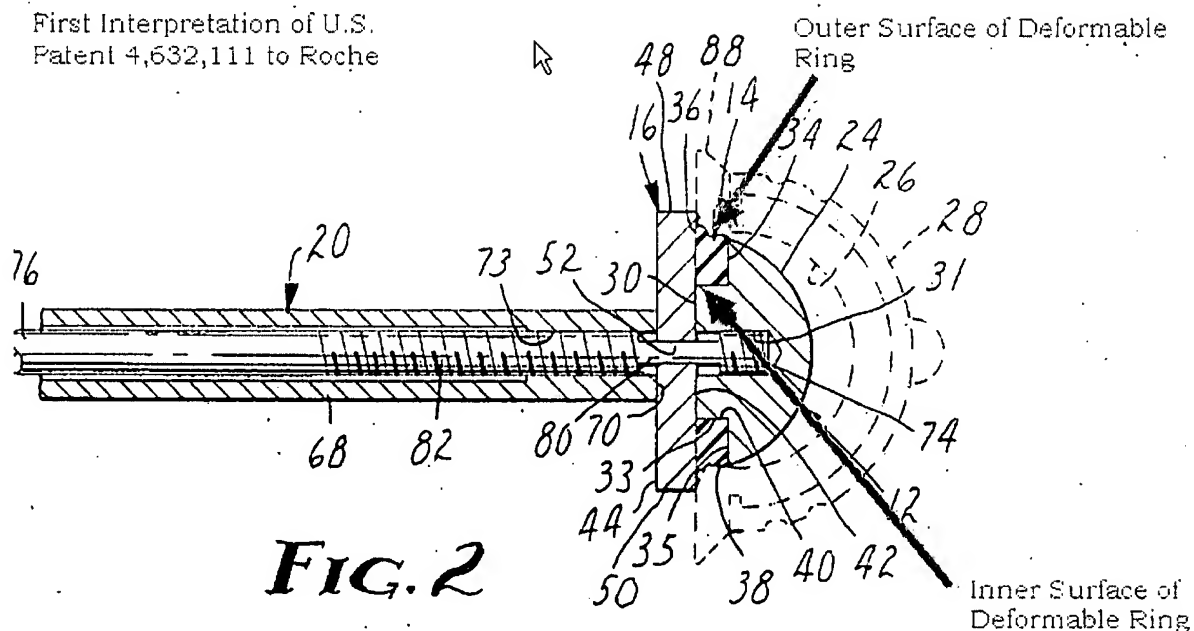
Claims 14, 16, 17, 21, 22, 24, 27, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Roche (U.S. Patent No. 4,632,111).

Roche discloses a method of for positioning a prosthetic acetabulum in a cavity of a patient's hip, comprising the steps of providing a tool having a handle for manipulating the acetabulum, the handle including a rod (ref. #76) and a head (ref. #24), the head adapted to cooperatively engage an inner face of an elastically deformable ring (ref. #14) of an endpiece that is used to grip an internal surface of the acetabulum and which endpiece is removably secured to the distal end of the handle, the elastically deformable ring including an outer surface adapted to wedge against an inner surface of the acetabulum and an opposite inner surface adapted to interact said endpiece with said handle, and wherein said handle further includes elements for applying a first force to urge said head into cooperative engagement with said inner surface of said elastically deformable ring to thereby radially expand said elastically deformable ring with respect to a longitudinal axis of said endpiece (col. 5, lines 60-end), placing said endpiece in engagement with said head of said handle and said head within said acetabulum and providing a first force between said head and said endpiece so as to provoke radial elastic deformation of said elastically deformable ring to thereby grip said acetabulum by said endpiece, positioning said acetabulum in said cavity of said patient's hip (col. 6, lines 20-22), applying a second force along said handle to

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cause said acetabulum to seat within said cavity of said patient's hip (col. 6, lines 25-55), disengaging said head from said endpiece and releasing said first force to allow said elastically deformable ring to recover to a non-expanded configuration (col. 6, lines 65-end), and withdrawing said endpiece from the positioned acetabulum (co. 7, lines 7-8). The elements for applying the first force to the head include a threaded portion on the rod (ref. #82), a grip (ref. #68) screwed on the threaded section and a movable sleeve (ref. #16) fitted between the grip and the head so that the head is positioned on the rod by rotating the grip on the threaded portion of the rod to move the sleeve to different positions on the rod. The first force is applied by rotating the grip to move the sleeve toward the endpiece secured to the tool. The tool includes a knob fixed to a proximal end of the tool (ref. #84). The second force is an impaction force applied to the knob fixed to the proximal end of the tool. The step of forcing the head into engagement with the deformable ring includes rotating a grip screwed on a threaded section of the rod in a first direction to urge a movable sleeve fitted between the grip and the head toward a distal position on the rod. The step of withdrawing the tool from the positioned prosthetic acetabulum includes rotating a grip screwed on a threaded section of the rod in a second direction to urge a movable sleeve fitted between the grip and the head toward a proximal position on the rod.

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Claims 14, 18-20 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Roche (U.S. Patent No. 4,632,111), according to a second interpretation.

Roche disclose a method of positioning a prosthetic acetabulum method for positioning a prosthetic acetabulum in an anatomical or prosthetic cavity of a patient's hip, comprising the steps of providing a tool having a handle for manipulating the acetabulum, the handle, including a rod (ref. #76) and a head (ref. #16), the head adapted to cooperatively engage an inner face of an elastically deformable ring (ref. #14) of an endpiece that is used to grip an internal surface of the acetabulum and which endpiece is removably secured to the distal end of the handle, the elastically deformable ring including an outer surface adapted to wedge against an inner surface of the acetabulum and an opposite inner surface adapted to interact said endpiece with said handle, and wherein said handle further includes elements for applying a first force to urge said head into cooperative engagement with said inner surface of said elastically

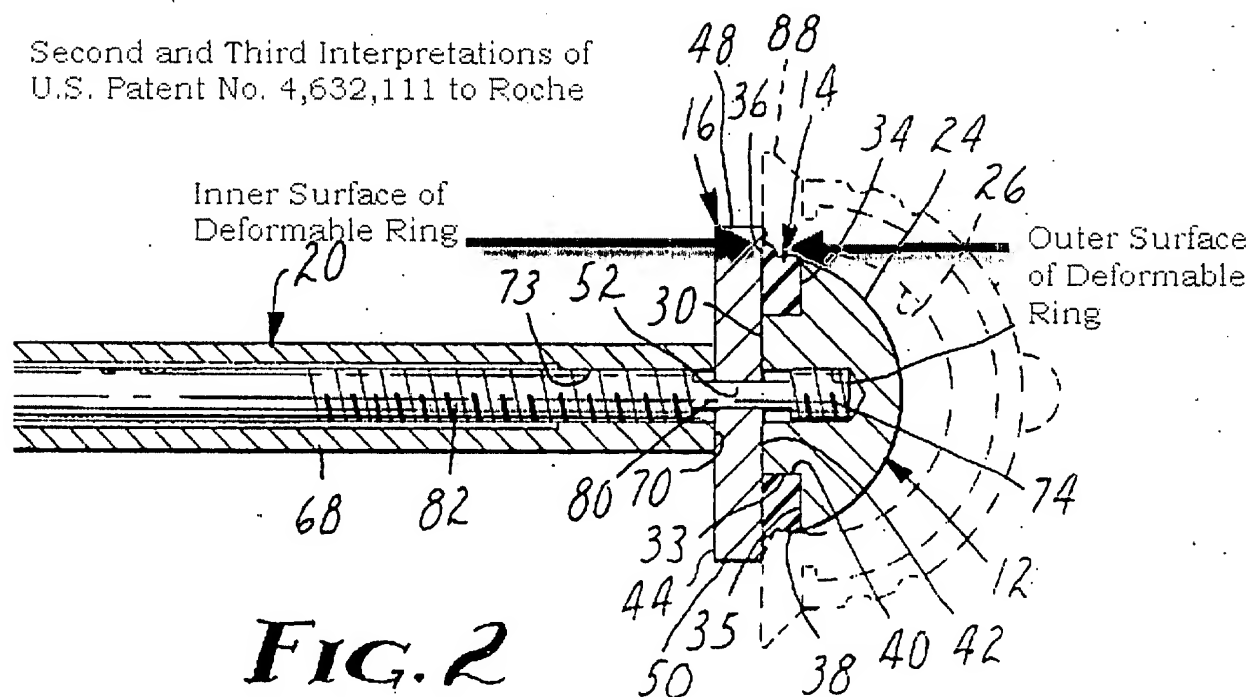
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deformable ring to thereby radially expand said elastically deformable ring with respect to a longitudinal axis of said endpiece, placing said endpiece in engagement with said head of said handle and said head within said acetabulum and providing a first force between said head and said endpiece so as to provoke radial elastic deformation of said elastically deformable ring to thereby grip said acetabulum by said endpiece, positioning said acetabulum in said cavity of said patient's hip, applying a second force along said handle to cause said acetabulum to seat within said cavity of said patient's hip, disengaging said head from said endpiece and releasing said first force to allow said elastically deformable ring to recover to a non-expanded configuration, and withdrawing said endpiece from the positioned acetabulum. The endpiece includes a supple part (ref. #14) and a rigid part (ref. #24) secured to the supple part, wherein the rigid part includes structure (ref. #31) for removably securing the rod to the endpiece, including a tapped section adapted to be secured to a threaded section on a distal end of the rod. The endpiece is secured to the rod by screwing the threaded section on the



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distal end of the rod into the tapped section of the rigid part of the endpiece.



Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Roche (U.S. Patent No. 4,632,111), according to a third interpretation.

Roche disclose a method of positioning a prosthetic acetabulum in a cavity of a patient's hip, comprising the steps of providing a tool having a handle that includes a rod (ref. #76) having a threaded medial portion (ref. #82) and a threaded distal portion (ref. #74), a movable sleeve (ref. #16) adapted to move in distal and proximal directions on the rod, a grip (ref. #68) adapted to rotate on the threaded medial portion of the rod to move the sleeve, a movable head (ref. #16) adapted to move in distal and proximal direction on the rod and to engage an inner surface of an endpiece, and an endpiece having an elastically deformable ring (ref. #14) mounted on a rigid part (ref. #24) that

contains a threaded portion to secure the endpiece to the rod, wherein an outer surface of the deformable ring (see above marked up-figure for inner and outer surfaces of deformable ring) is adapted to engage an inner surface of a prosthetic acetabulum when the head is forced on an inner surface of the deformable ring, placing the endpiece of the tool into the prosthetic acetabulum, forcing the head into the inner surface of the deformable ring (see above marked up-figure for inner and outer surfaces of deformable ring) by rotating the grip in a first direction to radially expand the deformable ring to an expanded configuration and secure the endpiece in the prosthetic acetabulum by gripping the inner surface of the prosthetic acetabulum with the outer surface of the deformable ring, positioning the prosthetic acetabulum in a cavity of a patient's hip, applying an impaction force to the tool to seat the prosthetic acetabulum in the cavity, disengaging the head from the inner surface of the deformable ring by rotating the grip in a second direction to allow the deformable ring to recover to a non-expanded configuration, and withdrawing the tool from the prosthetic acetabulum.

Claims 14, 18, 21, 22, 23, 24, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Glock (U.S. Patent No. 5,116,339).

Glock discloses a method for positioning a prosthetic acetabulum in an anatomical or prosthetic cavity of a patient's hip, comprising the steps of providing a tool having a handle for manipulating the acetabulum, the handle, including a rod (ref. #30) and a head (ref. #46), the head adapted to cooperatively engage an inner face of an elastically deformable ring (ref. #44A) of an endpiece that is used to grip an internal surface of the acetabulum and which endpiece is removably secured to the distal end of

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the handle, the elastically deformable ring including an outer surface adapted to wedge against an inner surface of the acetabulum and an opposite inner surface adapted to interact said endpiece with said handle, and wherein said handle further includes elements for applying a first force to urge said head into cooperative engagement with said inner surface of said elastically deformable ring to thereby radially expand said elastically deformable ring with respect to a longitudinal axis of said endpiece, placing said endpiece in engagement with said head of said handle and said head within said acetabulum and providing a first force between said head and said endpiece so as to provoke radial elastic deformation of said elastically deformable ring to thereby grip said acetabulum by said endpiece, positioning said acetabulum in said cavity of said patient's hip, applying a second force along said handle to cause said acetabulum to seat within said cavity of said patient's hip, disengaging said head from said endpiece and releasing said first force to allow said elastically deformable ring to recover to a non-expanded configuration, and withdrawing said endpiece from the positioned acetabulum. The endpiece includes a supple part (ref. #44A) and a rigid part (ref. #38) secured to the supple part, wherein the rigid part includes structure for removably securing the rod to the endpiece. The tool includes a knob (ref. #56) fixed to a proximal end of the tool. The second force is an impaction force applied to the knob fixed to the proximal end of the tool. The deformable ring includes a plurality petals (ref. #44A) where inner and outer surfaces of the deformable ring are constituted by inner and outer surfaces of the petals.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 25, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roche (U.S. Patent No. 4,632,111) in view of Bertuch, Jr. (U.S. Patent 4,305,394).

Roche discloses the claimed invention except for the additional steps of providing a plurality of endpieces having different sizes.

Bertuch, Jr. discloses that the components of the acetabular cup positioner can be varied in order to fit all types of manufactured acetabular cups of different sizes (see Abstract).

It would have been obvious to one of ordinary skill in the art to provide the endpiece of Roche in different sizes in view of Bertuch, Jr. in order to fit all types of manufactured acetabular cups of different sizes.

Claims 15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glock (U.S. Patent No. 5,116,339) in view of Bertuch, Jr. (U.S. Patent 4,305,394).

Glock discloses the claimed invention except for the additional steps of providing a plurality of endpieces having different sizes.

Bertuch, Jr. discloses that the components of the acetabular cup positioner can be varied in order to fit all types of manufactured acetabular cups of different sizes (see Abstract).

It would have been obvious to one of ordinary skill in the art to provide the endpiece of Glock in different sizes in view of Bertuch, Jr. in order to fit all types of manufactured acetabular cups of different sizes.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER